



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,414	09/30/2005	Keiichi Kawagoe	Q90666	4000
65565	7590	02/17/2011		
SUGHRUE-265550				
2100 PENNSYLVANIA AVE. NW				
WASHINGTON, DC 20037-3213				
EXAMINER				
ANDERSON, REBECCA L				
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE		DELIVERY MODE		
02/17/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SUGHRUE265550@SUGHRUE.COM

USPTO@SUGHRUE.COM

PPROCESSING@SUGHRUE.COM

Office Action Summary

Application No.

10/551,414

Applicant(s)

KAWAGOE ET AL.

Examiner

REBECCA L. ANDERSON

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10, 14, 28 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) 28 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10 and 14 is/are rejected.
- 7) ☒ Claim(s) 1, 10, 14, 32-34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

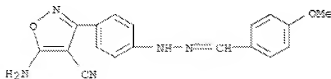
DETAILED ACTION

Claims 1, 10, 14, 28 and 32-36 are currently pending in the instant application. Claims 1, 10 and 14 are rejected. Claims 1, 10, 14, 32-34 and 36 are objected. Claims 28 and 35 are withdrawn from consideration as being for non-elected subject matter.

Response to Amendment and Arguments

Applicants' amendment and arguments filed 8 December 2010 have been considered and entered into the instant application.

Applicants' amendment to the claims has overcome the 35 USC 102(b) rejection over the compound:



of Willitzer et al.

In regards to the claim objections, as the claims are still rejected under 35 USC 102(b), the objection is maintained as the claims still include withdrawn subject matter.

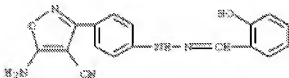
Election/Restrictions

Applicant's election without traverse of Group I and the further election of the compound (4-pyridinecarboxyaldehyde 4-(oxazole-5-yl)phenylhydrazone) in the reply filed on 8 July 2008 has been previously acknowledged.

As per MPEP 803.02, the examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species is considered allowable and Applicant has overcome the previous 35 USC 102(b) rejections. Therefore, according to MPEP 803.02:

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable **, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. the elected species shall be rejected, and claims to the nonelected species will be held withdrawn from further consideration.

As the elected species has been found allowable, the examiner has expanded the search and examination to the following compound:



Claims 1, 10, 14, 32-34 and 36 have been examined to the extent that they are readable on the elected embodiment, the elected species and the additional species indicated above. Since the elected embodiment is not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration. Claims 28 and 35 are therefore withdrawn from consideration as being for non-elected subject matter. It has been determined that the entire scope claimed is not patentable.

Claim Objections

Claims 1, 10, 14, 32, 33 and 36 are objected to as containing non-elected subject matter. Claims 1, 10, 14, 32, 33 and 36 presented drawn solely to the elected embodiment would overcome this objection.

Claim 36 is objected to because of the following informalities: Claim 36 ends in a comma instead of a period. Additionally, it is suggested that the term "or" be added before the last listed compound of the claim. Appropriate correction is required.

Allowable Subject Matter

Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

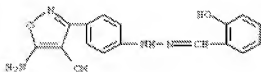
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Willitzer et al., DD 152786.

Willitzer et al. discloses the compound:



on page 3, table 1 wherein R1 is H and R2 is O-HO-C6H4-CH=N-, see the first table in the reference. Administration data in ml/L is also disclosed. Please note that the intended use in claim 14 does not render a known or obvious composition patentable, see *In re Tuominen*, 213 USPQ 89 (CCPA 1982). Additionally, a recitation of the intended utility in the preamble does not impart

patentability to a known composition. In re Spada, 911 F.2d 705, 15 USPQ.2d 1655 (Fed. Cir. 1990). The compound in Willitzer corresponds to applicants instantly claimed invention wherein R1 is H; R2 is phenyl substituted with one Group (A); wherein Group (A) is hydroxyl; R3 is H; Ar is phenylene; X is a single bond; and G is oxazole substituted with two group (C) substituents wherein group (C) is cyano and amino.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

4 February 2011

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600